

REMARKS

ADMINISTRATIVE PROCEDURE ACT STANDARD FOR PATENT OFFICE

REJECTIONS

The Administrative Procedure Act (APA), standard for Patent Office examination is stated in law as follows. As set forth in Dickenson v. Zurko 50 USPQ 2d 1930 (1999) for any Patent Office decision to be lawfully made, it must not be arbitrary or capriciously made, but must be bound up with a record based factual conclusion to determine if it is supported by substantial evidence. Logic and experience is required to be applied to the evidentiary record Dickenson v. Zurko, 1936 (1999). The standard of review governing a Patent Office decision, holds unlawful; any arbitrary, capricious decision or a decision unsupported by substantial evidence. In reviewing a decision, review is of the whole record, requiring the substantial evidence standard be met which asks whether a reasonable mind might accept a particular evidentiary record as adequate to support a conclusion. Dickenson v. Zurko, at 1935. See In Re. Kotzab 217 F. 3d 1365, 1370 (Fed. Cir 2000) requiring the Patent Office rejection be "based on particular findings." See In Re. Gartside 203 F.3d 1305, 1312 (Fed. Cir. 2000) requiring that a rejection be based on substantial evidence meaning "...such relevant evidence as a reasonable mind might accept as adequate to support a conclusion..."; and that a Patent Office decision, "must explicate its factual conclusions enabling... [the Court...] to verify readily whether those conclusions are indeed supported by 'substantial evidence'..." at 1314 Underlining added). (hereafter "APA Standard"). In summary, Examiner's grounds of rejection are his bare conclusions, without the support of any facts in the record or support by substantial evidence. (hereafter "APA Standard") The APA Standard is incorporated in all arguments made for patentability or traversing Examiner's grounds of rejection, in any manner.

1. With regard to Paper No.5, paragraph 1, Applicant has amended original Claims 78-92, renumbered as 1-15, for proper dependency. New Claim 16 -31 are added.

2. Claim 1 is amended to provide an antecedent basis for the recitation of "the end of said bowler's finger," in Claims 2 and 5, and "the" is changed to "a."

3. With regard to paragraph 2, Claims 2, and 5, and 13 have been amended to meet Examiner's rejection under 35 U.S.C. 112, 2nd paragraph. The recitation of Claim 15 is within and complies with, 35 U.S.C. 112, as originally submitted and no change is made, except to change dependency.

4. Claim 13 is amended by adding: "connected to said finger pad shield means, for placing said contact area in contact with said finger pad," as recited in Claim 1.

5. Examiner's statement of rejection of Claim 15 under 35 U.S.C. 112 is stated as,

Claim 15 is narrative and function (sic) and fails to provide any positive limitations that further limits the structure of the claimed apparatus.

Examiner's rejection of Claim 15 as "narrative," "function" (sic) and for "failing to provide any positive limitations that further limits the structure of the claimed apparatus," is a naked conclusion without any support by a factual record or support by substantial evidence. Examiner has not provided any fact to support the allegations of "narrative" or "function," or "[fails] to provide any positive limitations that further limits the structure of the claimed apparatus," and has not provided any authority in law to support a rejection as "narrative," or "function," or "failure to provide any positive limitations that further limits the structure of the claimed apparatus." The difficulty with Examiner's rejection is that as a statement, it is without any basis in fact, is vague and ambiguous and leaves the Applicant to guess at the grounds of rejection, denying to the Applicant the right and opportunity to try to meet Examiner's rejection under 35 U.S.C. 112. This vague and ambiguous statement by Examiner is a failure to meet the

APA standard, as stated in the APA Standard, see page 9 above.

Claim 15 is dependent from "means plus function" claim 1 and is written as a means plus function claim in means plus function language, as permitted under 35 U.S.C. 112, 6th paragraph, and any functional limitation is expressly permitted.

Claim 15 recites that the finger pad shield means, as recited in Claim 1,

Is made substantially resist deformation in said contact area from the force of said bowling ball.

The force of the bowling ball, as recited in Claim 15, is recited in parent Claim 1, paragraph c, as

...the force of said bowling ball when a bowler's maximum force is applied by said finger pad to the bowling ball in releasing the bowling ball.

The support for Claim 15 and in particular, the maximum force is described in the specification in pages 23 and 24, relative to the limit of muscular skeletal development and as the maximum force which can be applied to the bowling ball within a range of muscular skeletal development. The Declarations of Dr. W Robert Addington, DO, submitted with this Application and with this Rule 111 Amendment, are incorporated and made a part of this Rule 111 Amendment, the same as if repeated here in its entirety. Dr. Addington, states in paragraph 3,

I am skilled in human muscular skeletal development. I know there exists a limit to that development and the maximum force which can be applied to a ...bowling ball,...

Dr. Addington's statement is of an expert's facts and must be given due weight as an expert's opinion. The functional limitation expressed in Claim 15 is on a "finger pad shield means," "adapted to spread said force of said bowling ball over said contact area of said first surface for reducing the pressure over said contact area." (see recitation of Claim 1), "to substantially resist deformation in said contact area from said force of said bowling ball" (see Claim 15), "when a bowler's maximum force is applied ... to the bowling ball..." The limitation in Claim 15 is a functional limitation directed to the finger pad shield means and is stated in relation to the maximum force a bowler is capable of exerting within the limit of human muscular skeletal development. That recitation in the Claims is supported in the specification and is a positive limitation, definable by medical science, as stated by Dr. W. Robert Addington, DO in his Declarations..

Examiner's rejection, is wrong under law as applied to a "means plus function" claim. The use of the term, "means for," generally invokes 35 U.S.C. 112, 6th paragraph and there is no particular language that must appear in a claim in order for it to fall within the scope of 35 U.S.C. 112, 6th paragraph. Manual of Patent Examining Procedure (MPEP) §2181, Page 2100-160. Examiner has made no fact based reasoned conclusion which would alert, inform or notify, Applicant, why, Claim 1 is not a "means plus function" claim.

Terms such as "adapted," "so constructed and located," "for providing," are acceptable as "means plus function" recitations MPEP §2181, page 2100-160. Applicant's recited "made" or "made to," followed by a functional limitation are functional limitations as are the Patent Office accepted "adapted to" and are closer in reciting a functional element than the Patent Office accepted "for providing" or "so constructed and located." See MPEP§2181

Under the APA Standard, see page 6 above, Examiner must provide a fact based

conclusion based on substantial evidence and supported by law, why, as Examiner has stated, Claim 15 is "narrative," is "function (sic)," and "fails to provide any positive limitation that further limits the structure of the claimed apparatus." Examiner has not met that APA Standard, see page 6 above. Any restatement of Examiner's rejection under these grounds, should be as a first action as Examiner's ambiguous and incomplete rejection has denied Applicant a fair chance to amend the claims.

6. Claims 1-5 and 9-15 stand rejected under 35 U.S.C. 102(b) as anticipated by Fowble.

A rejection under 35 U.S.C. 102(b) requires the Examiner show in a single reference every element of the claim. Manual of Patent Examining Procedure § 2131, Page 2100-54.

Knowledge of One Skilled in the Art

Prior to the filing date of this application, one skilled in the art of bowling knew the conventional method of releasing a bowling ball with rotation down the alley and spin to achieve pin scattering, by inserting (a) middle finger(s) into the ball finger hole, and releasing the ball by placing the ball on the middle finger(s) and applying a first force against the ball through that inserted finger and the ball's finger hole, to lift the ball to rotate and spin the ball and producing a counter second force, as well known by every one who ever bowled and from Newton's commonly known second law that for every action there is a reaction, See 1984 U.S. Patent 4,371, 161, Shaffer ("Shaffer"). This conventional bowling method is shown in Shaffer, column 3 lines 33 to 65 and column 4, lines 1 to 18, and with particular attention to the disclosure in Shaffer, column 3, lines 45 to 52, and column 4, lines 10 to 17, describing the known method of using the finger pad in the bowling ball finger hole to "rotate the underside of the ball upward, an effect called 'lift', as the ball is in the process of release from the finger pad. The

application of a force on the ball from the finger pad inserted into the bowling ball finger hole, as is well known, produces a counter force from the bowling ball against the bowler's finger pad. See Declaration of R.A. Addington stating what was known to those skilled in the art as of the filing date, and in particular about "lift" applied to the ball in releasing a bowling ball, to impart rotation and spin through the bowler's middle finger.

One skilled in the art reading Claims 1-32 would understand what is meant in the claim by the recitation of a maximum force is applied by said finger pad to the bowling ball, in releasing the bowling ball.

What Fowble does not show and as recited in Claim 1 is the recitations of,

- c. said second surface for insertion into the finger hole of a bowling ball against the interior wall of said finger hole and for receiving a force of said bowling ball when a maximum force is applied by said finger pad to the bowling ball, in releasing the bowling ball;
- d. means for placing, connected to said finger pad shield means, for placing said contact area in contact with said finger pad; and wherein
- e. said finger pad shield means is made of a rigid material adapted to spread said force of said bowling ball over said contact area of said first surface for reducing the pressure over said contact area.

While Examiner states,

The recitations in paragraph c. are functional and fail to distinguish over Fowble.

However, that statement fails to meet the legally required standard for Patent Office

examination, as set forth in the APA Standard, see page 6, above. First, Examiner's statement is wrong because Claim 1 is means plus function claim written under 35 U.S.C. 112, 6th paragraph and functional language is expressly permitted (see Paragraph 5, above). Second, Examiner is parsing the individual elements of the Claim, when the Claim elements should be examined as a whole. Functional language does not, in and of itself render a claim improper and a functional claim must be evaluated and considered just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. MPEP § 2173.05(g), Page 2100-151. Functional limitations may be used to define a capability or purpose of an element. Id.

The plain meaning of the Claim 1, comprises the functions of,

receiving the force of said bowling ball when a bowler's maximum force is applied by said finger pad to the bowling ball in releasing the bowling ball (paragraph c.) and,

spread said force of said bowling ball over said contact area of said first surface for reducing the pressure over said contact area (paragraph d).

The function recited in Claim 1, is the function of the finger pad shield means to spread the force received from the bowling ball,

...when a bowler's maximum force is applied by said finger pad to the bowling ball, in releasing the bowling ball.

That recitation is supported in the specification and describes the invention in the functional language of what the finger pad shield means "does" under the force of the ball when the bowler's maximum force is used in releasing the ball. What something

does is the same as how it functions. In the case of the recited claims, the function that is done is spreading the force when a bowler's maximum force is applied to release the ball. Given the support in the specification for the Claims 1 and 15 (see Paragraph 5, above and the Declarations of Dr. W. Robert Addington, DO. and R.A. Addington) the invention of a finger pad shield means for spreading the force of the bowling ball produced when the bowler is using the maximum force to lift the ball at release, is what is fairly conveyed to a person skilled in the art. Examiner is being unfair in ignoring or disregarding and rejecting that meaning without explaining his basis in fact and law and Examiner's ground of rejection has failed the APA Standard, see page 8, above.

Accordingly, the recitations in Claim 1, are properly functional under 112, 6th paragraph and define the finger pad shield means in terms of what it does, its capability and purpose.

Fowble does not show the above claimed elements. Fowble is a finger pad limited to use in picking up material which may gall or chafe the fingers. There is no disclosure in Fowble of,

receiving the force of said bowling ball when a bowler's maximum force is applied by the finger pad shield means to the bowling ball, and

said finger pad shield means is made of rigid material for spreading the force of said bowling ball over said contact area.

Claim 2 is rejected as anticipated by Fowble. Claim 2 is dependent from Claim 1 and the limitations of Claim 1 are read with the limitations of Claim 2. Fowble does not show any capability for "locating" the contact area on the finger pad so the force is spread over the contact area. The device of Fowble is limited to an undefined "hardness" intended to reduce wear incident to handling of building material.. See Column 2, lines

60-67. But no where in Fowble is there any disclosure of the means and functions as recited in Claims 1 or 2.

Claims 3, 4 and 5 are allowable as dependent from allowable claim 1 (amended).

The disclosure of Fowble does not show a limit means or a raised surface, as recited in Claim 9,10, and 11. The device of Fowble is limited to picking up building material and not to the functions or structure, purposes or capabilities, as recited and as would be understood by one skilled in the art of bowling. Examiner has shown no factual basis for rejecting these Claim except what he can read into Fowble by the hindsight he gains from a this Application, or by speculation.

Claim 9, 10 and 11 are allowable as dependent from an allowable Claim 1 (Amended). Fowble does not show any limit means. The device shown by numeral 26 is described in the specification as a "limit means." What Examiner states in Fowble as his numerals 1 -5 and identifies as limit means 6, with or without a raised surface to engage the surface of a bowling ball, is Examiner's reading of these claimed features into Fowble after reading this Application and relying on the benefit of hindsight, There is nothing in Fowble to suggest these recited features or elements such as the limit means or raised surface or support means, and without such hindsight, there can be no showing of these features in Fowble. Any of the Examiner identified features of Fowble cannot be the recited "limit means" because there is nothing in Fowble shown for that function or having that recited structure.

Claims 6-8 are rejected as obvious over Fowble in view of Pratt under 35 U.S.C. 103. Examiner has failed to meet the basic requirements of a prima facie case of obviousness under 35 U.S.C. 103, as set forth in MPEP § 2343 et seq. This ground of rejection has no basis in Fowble because, Fowble does not show or disclose any part of the Claims 6-8, dependent on Claim 1 (amended) or use of the device of Fowble in a glove or in any context connected with bowling. This ground of rejection has no basis in

Pratt because Pratt is not connected with or used in the context of, bowling. Pratt is for use by one handling coins, such as a gambler who need a flexible insert to provide a resilient contamination barrier for protection when picking up coins. The use of the insert of Pratt is for picking up coins and must be flexible while providing a barrier. The device of Fowble is for a surface hard enough to resist abrasion, unlike Pratt which is not concerned with abrasion but with a flexibility adequate to pick up coins. Pratt does not teach, show, disclose or suggest, any of the recited elements in Claims 8-10, dependent from Claim 1, and is inapplicable to these Claims. Applicants' recited elements in Claims 6-8 are not shown in Pratt or Fowble and this ground of rejection is deficient in fact and law.

The disclosures of Fowble and Pratt are each not connected to or related to bowling and are opposite, as Pratt's device must use flexible finger protectors to be able to pick up coins which Fowble's device is not concerned with picking up coins but in protection from abrasion from rough building materials. These are two separate objects which are taught separately and not suggested for combination in any one for the other and there is no teaching, disclosure or suggestion sufficient in Fowble or Pratt, to make a prima facie case of obviousness. The logical direction of development for Pratt would be inserts which are more tactile and more closely duplicate the operation of the finger pad skin surface so objects such as coins may be grasped easily. This development is opposite to Fowble which must have a surface intended to resist abrasion, which is not an object in Pratt. Examiner has not shown the combinability of Pratt and Fowble in a bowling device in clear and particular terms. See APA Standard page 6 above; see Winner Intern. Royalty Corp. v. Wang 202 F.3d 1340, 1348 (Fed. Cir. 2000)

New claims 16 - 22 are not anticipated or by Fowble or Pratt or made obvious by Fowble combined with Pratt.

Claim 16 recites, as a means plus function claim, under 112, 6th paragraph, a bowler's

finger pad shield for protecting a bowlers finger pad on a bowler's middle finger inserted into a bowling ball finger hole. See the recitation of claim 16, above.

New Claim 16 describes to one skilled in the art, in means plus function language, the claimed invention. Claim 16 is a functional claim which must be evaluated and considered just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. MPEP § 2173.05(g), Page 2100-151. Functional limitations may be used to define a capability or purpose of an element. Id.

The Knowledge of One of Ordinary Skill in the Art

Applicant incorporates the statement made above in Paragraph 6, on page 13-14, with regard to the knowledge of one skilled in the art and the understanding of the claimed subject matter by one skilled in the art.

Prior to the filing date of this application, one skilled in the art of bowling knew the conventional method of releasing a bowling ball with rotation down the alley and spin to achieve pin scattering, by inserting (a) middle finger(s) into the ball finger hole, and releasing the ball by placing the ball on the middle finger(s) and applying a first force against the ball through that inserted finger and the ball's finger hole, to lift the ball to rotate and spin the ball and producing a counter second force, as well known by every one who ever bowled and from Newton's commonly known second law that for every action there is a reaction, See 1984 U.S. Patent 4,371, 161, Shaffer ("Shaffer"). This conventional bowling method is shown in Shaffer, column 3 lines 33 to 65 and column 4, lines 1 to 18, and with particular attention to the disclosure in Shaffer, column 3, lines 45 to 52, and column 4, lines 10 to 17, describing the known method of using the finger pad in the bowling ball finger hole to "rotate the underside of the ball upward, an effect called 'lift', as the ball is in the process of release from the finger pad. The application of a force on the ball from the finger pad inserted into the bowling ball finger

hole, as is well known, produces a counter force from the bowling ball against the bowler's finger pad. See Declaration of R.A. Addington stating what was known to those skilled in the art as of the filing date, and in particular about "lift" applied to the ball in releasing a bowling ball, to impart rotation and spin through the bowler's middle finger.

The plain meaning of new Claim 16 is the finger pad shield which is held in place over the bowler's middle finger pad and placed in the bowling ball finger hole, for applying lift to the ball when releasing it and that the force applied to release and lift the ball produces a counter force against the finger pad shield which spreads that force over the contact area made with the finger pad.

Fowble shows a cover for a finger to protect it when picking up building materials. There is nothing in Fowble which teaches any element of Claim 16.

For the recitations of Claims 17 -32, Applicant states there is nothing in Fowble or Fowble and Pratt that anticipates or makes obvious any of the Claims 1-32.

In Claims 17 and 18, there is no showing of a means for protecting a finger pad shield from the force from the bowling ball produced by said maximum force is within a range limited by the limit of muscular skeletal development or the force produced by a bowler applying a maximum force for releasing and lifting said bowling ball is limited by a maximum weight of a bowling ball and the limit of muscular skeletal development.

Claims 19-30 recite the apparatus of the finger pad shield in structural terms defining its structural strength, form and size. These recitations are not shown or suggested Fowble or Pratt, For Claims 19-30, there is nothing in Fowble or Fowble and Pratt that anticipates or makes obvious, any of the recitations in these claims. There is nothing in Fowble disclosing the elements, as recited in Claim 19. See claim 19, above.

Fowble does not show, as described in the Application, and in the Declarations filed with this Application and this Amendment, the above recited elements in Claim 19, expressly or inherently because the hardness and resistance to bending or deformation, of the rubber material used in Fowble is not expressed in terms other than a hardness sufficient to prevent the building materials from abrading the finger. Accordingly, there is nothing in Fowble disclosing anything to protect the finger which can function, as claimed to spread the force of the bowling ball over the contact area of the first surface of the finger pad shield means or disclosing a finger pad is formed to be substantially rigid to resist deformation from a force of a bowling ball produced by a bowler's maximum force applied by the bowler's finger pad inserted in the finger hole of said bowling ball to lift to said bowling ball in releasing said bowling ball, as recited in Claim 19. Fowble does not disclose the claimed invention because it is devoid of anything disclosing the forces on the bowler's finger in lifting the ball at release produced by the maximum force of the bowler to the ball in the release.

The quality of the hardness of Fowble can not be read as disclosing the recited claimed function of spreading the force over the contact area except by hindsight and by reading into Fowble, a quality of hardness for the rubber disclosed in Fowble, sufficient to resist any deformation from the bowler's maximum force such that the force produced is distributed or spread over the contact area and is not limited to an area within the said contact area by the flexing and deforming action of the rubber shield of Fowble, localizing the force to the area under the deformation and preventing the material from spreading the force over the said contact area. The claimed finger pad shield spreads the force produced by the bowling ball when a bowler's maximum force to the limit of muscular skeletal development, is applied to the ball in releasing the ball. Fowble is a blank on disclosing anything even remote to the claimed elements. The recitation in Claims 1, 16 and 32, of spread said force of said bowling ball over said contact area of said first surface for reducing the pressure over said contact area, is not met by Fowble expressly or inherently because the hardness and resistance to bending or

deformation, of the rubber material used in Fowble is not expressed in terms other than a hardness sufficient to prevent the building materials from abrading the finger.

Accordingly, there is nothing in Fowble disclosing a means to protect the finger which can function, as claimed to spread the force of the bowling ball over the contact area of the first surface of the finger pad shield means or to resist deformation of a force of a bowling ball produced by a bowler's maximum force applied by the bowler's finger pad, as recited in Claims 19, 20, 21. The quality of the hardness of Fowble can only be read as disclosing the recited claimed function of spreading the force over the contact area by reading into Fowble, a quality of hardness sufficient to resist any deformation from the bowler's maximum force such that the force produced is distributed or spread over the contact area and not limited to an area within the said contact area by the action of the rubber shield of Fowble to deform and prevent the material from spreading the force over the said contact area.

Claim 22 reciting, said finger pad shield is formed to be substantially rigid to resist deformation and to spread said force of a bowling ball produced by a bowler's maximum force applied by the bowler's finger pad, over said contact area uniformly, is not disclosed by Fowble because Fowble is limited to a vulcanized finger cover to prevent abrasion and there no disclosure of resisting deformation or spreading a force against the finger cover over the contact area or to spread the force uniformly.

Claim 23, reciting the finger pad shield is formed to be substantially rigid to resist deformation and to spread said force of a bowling ball produced by a bowler's maximum force applied by the bowler's finger pad over said contact area to prevent pressure spots within said contact area , is not met or disclosed by Fowble for the reason given for Claims 19-22 and for the reason that Fowble does not teach or disclose a structure that resists deformation to spread the force over the contact area as in the claimed elements where the structure is substantially rigid to resist deformation and spread the force of the over the contact area so that "pressure spots

within said contact area, " are prevented.

Claims 24 to 26 recite the finger pad shield is attached to the finger part of a glove. These Claims are not shown, or taught or described by Fowble or Pratt or by Fowble or Pratt in any combination, for the reasons given above for Claims 6, 7 and 8, as if repeated here in their entirety.

Claim 27 is not disclosed in any way by Fowble or Fowble and Pratt, for the reasons given for Claim 9.

Claim 28 is not disclosed in any way by Fowble or Fowble and Pratt, for the reasons given for Claim 12.

Claim 29 is not disclosed in any way by Fowble or Fowble and Pratt, for the reasons given for Claim 10.

Claim 30 is not disclosed in any way by Fowble or Fowble and Pratt, for the reasons given for Claim 14.

Claim 31 is a not disclosed in any way by Fowble or by Fowble and Pratt, for the reasons given for Claim 16..

Claim 32 is a not disclosed in any way by Fowble or Fowble and Pratt for the reasons given for Claim 23.

Accordingly, all of the Claims in this Application are allowable.



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